

REMARKS

Claims 1 to 20 are pending in this application. Claims 1 to 20 are subject to restriction under 35 U.S.C. § 121.

Restriction Requirement

The present Office Action requires restriction among the following groups:

Group I: Claims 1-5 and 7 drawn to a compound and composition of formula (I)

Group II: Claim 6 drawn to a method of use of a compound of formula (I).

Group III: Claims 8-20 drawn to a method of treating a disease.

The Office Action alleges that the inventions of Groups I-III are related as product and method of use and that a search would impose a burden if unrestricted.

It is also alleged that the products of Groups I-III differ materially in structure and in element. Applicant respectfully traverses the requirement for restriction and respectfully requests reconsideration of the requirement itself.

According to MPEP § 803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05-§ 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) to § 806.04(i), § 808.01(a), and § 808.02).

Applicant respectfully submits that Groups I-III should be rejoined because examination of compounds of the present invention and methods of using these same compounds would not impose a serious burden on the Examiner. For example, a search for art related to the compounds of the present invention would necessarily also uncover art related to methods of using the same compounds. Accordingly, Applicant submits that the same search could be used for examination of all three grouped inventions. To be fully responsive, however, Applicant hereby elects the claims of group I while reserving the right to prosecute the claims of non-elected groups in future continuing or divisional applications.

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The Office Action also requires an election of a single compound. The Undersigned thanks the Examiner for clarifying in a telephone call on August 3, 2004 that the compound election is a species election and that the election is being made to aid the Examiner in conducting a search and examination of the claimed subject matter, and is not to be construed as limiting the scope of Applicant's claims. Accordingly, it is Applicant's understanding that if the elected subject matter is found to be allowable over the prior art, the search and examination will be expanded to cover the other species. With this understanding, Applicant elects the compound of example 1, [3-(4-chlorobenzoyl)-5-(4-chlorophenyl)-1*H*-indol-1yl]acetic acid (R₁, R₂, and R₃ are, independently, hydrogen and R₄ and R₅ are, independently, phenyl substituted with chlorine). Claims 1-3 and 6-20 read on the elected species.

Applicant believes that the foregoing constitutes a complete and full response to the Office Action of record. An early and favorable consideration of the present application is respectfully requested.

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